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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,334	12/18/2001	William E. Webler	ACS-60270 (2022P)	3477

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EXAMINER

ORTIZ, ANGELA Y

ART UNIT	PAPER NUMBER
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1732

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/025,334

Applicant(s)

WEBLER ET AL.

Examiner

Angela Ortiz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 20-24,33 and 34 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-19,31 and 32 is/are allowed.
- 6) ☒ Claim(s) 25-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement..

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/27/02.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-19 and 25-32, drawn to a method for forming a window in a device having distal and proximal tubular members, classified in class 264, subclass 486.
- II. Claims 20-23, drawn to a window for an intracorporeal device formed by the method of claim 1, classified in class 600, subclass 176.
- III. Claims 33-34, drawn to an intracorporeal device, classified in class 600, subclass 176.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process could be used to make a non-intracorporeal device such as an endoscope for non-medical applications (e.g., inspecting internal and difficult-to-access components of mechanical systems such as engine parts).

Inventions III and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed

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does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because it does not require placing a window preform in a mold and applying force effective to urge proximal and distal members together to deform the window preform. The subcombination has separate utility such as a non-intracorporeal device such as an endoscope for non-medical applications (e.g., inspecting internal and difficult-to-access components of mechanical systems such as engine parts).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I and II is not required for Group III, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Paul Y. Feng on 10/26/2004 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-19 and 25-32. Affirmation of this election must be made by applicant in replying to this

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Office action. Claims 20-24, 33 and 34 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 25-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Wilson, USP 6,103,037.

The cited reference teaches the claimed method of joining a plastic part with a tubular member wherein a catheter is formed comprising welded overlapping jacketed sections made integral with a stainless steel braid layer 22. The method further comprises providing a mandrel 124, covered with a Teflon inner layer including a metal tubular form 122 as the exterior surface, and forming an assembly. The surface may be coated with a sleeve to make application of the jacket layers more facile. The jacket sections 112, 114, 116 are cut axially and loaded onto the assembly with some spacing

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provided. A shrink tube is placed over the entire assembly, and is then is placed in an oven to heat and soften the jacketed sections. As the tube is shrunk over the assembly, either during or after heating, it applies a force and compresses the jacket sections to weld the sections together. See col. 6, lines 50-67; col. 7, lines 9-12, 20-40; col. 8, lines 1-5, 16-35.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson, USP 6,103,037.

The cited primary reference substantially teaches the basic claimed method of joining a plastic part with a tubular member wherein a catheter is formed comprising welded overlapping jacketed sections made integral with a stainless steel braid layer 22. The method further comprises providing a mandrel 124, covered with a Teflon inner layer including a metal tubular form 122 as the exterior surface, and forming an assembly. The surface may be coated with a sleeve to make application of the jacket layers more facile. The jacket sections 112, 114, 116 are cut axially and loaded onto the assembly with some spacing provided. A shrink tube is placed over the entire assembly, and is then is placed in an oven to heat and soften the jacketed sections. As the tube is shrunk over the assembly, either during or after heating, it applies a force and compresses the jacket sections to weld the sections together. See col. 6, lines 50-67; col. 7, lines 9-12, 20-40; col. 8, lines 1-5, 16-35.

The cited primary reference does not teach use of ceramic materials for the tubular preform.

Note that ceramic materials are comparable in strength to metal materials and it would have been obvious to one of ordinary skill in the art at the time the invention was made to use any conventional material for the tubular preform, as an alternative material for achieving equivalent results.

Allowable Subject Matter

Claims 1-19 and 31-32 are allowed.


Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. USP's 4213536; 5017259; 5160559; 5514115; 5776114; 5811043; 5948184; 5951929; 6063318; 6375774; 6548010; 6797217.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Angela Ortiz whose telephone number is 571-272-1206. The examiner can normally be reached on Monday-Thursday 9:00-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianne can be reached on 571-272-1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Angela Ortiz
Primary Examiner
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